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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,885	10/17/2001	Robert B. Haines	10013718-1	7082

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,885

Applicant(s)

HAINES, ROBERT B.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Examiner withdraws the objections to claims 1-3, 31-32, and 34 due to Applicant's amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites "the single respective fluid-based marking is imprinted on the edge portion and not imprinted on the facial portion". This is confusing and appears contradictory, as claim 3 depends on claim 1 that states "the single fluid-based marking being on a facial portion of the facial portions **and** on an edge portion of the edge portions". Based on this contradiction, claim 3 could be a different invention and would be distinct from claim 1, thereby requiring a restriction. To claim 34, that a sheet does not have sufficient capillary action to carry the fluid-based marking onto the face portion from the edge portion is not clear. It is not understood how such action carries ink onto the face from the edge.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 31-34, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4278722 to Hoppe et al. in view of USPN 6582138 to Meunier et al.

5. Hoppe discloses a multilayer edge sealed record carrier of paper and film. Hoppe employs a printed sheet of paper (inherently having top and bottom facial portions) having a print of identification data (equivalent to "media parameters" of instant claim 32) that extends without interruption from the paper surface and film over the edge (col. 4, lines 60-68 of Hoppe) (equivalent to the marking of a face being perpendicular and adjacent to an edge). Hoppe does not disclose the printed identification data is of a single-fluid marking such as ink (instant claim 4) or that the marking is a barcode (instant claim 33) or that there are a plurality of sheets (instant claims 5, 38, and 39). Meunier teaches an authenticated sheet material using printed ink.

Meunier discloses marking an edge of the sheet or sheets of material with indicia arranged to form a unique code identifying the sheet of material, wherein the sheet of material includes a first surface, a second surface disposed opposite the first surface and an edge extending between the first surface and the second surface and peripherally about the sheet of material (col. 2, lines 45-68, col. 4, lines 25-30, col. 6, line 54, and col. 7, lines 20-21 and lines 45-55 of Meunier).

The edge marking is of visible or invisible ink (col. 3, lines 3-5 of Meunier) and has been printed or recorded with information (col. 7, lines 45-46 of Meunier) (instant claim 37). Meunier shows a ream identifier (22) (barcode) on stacks of sheets of paper (ream 20) and a single sheet of paper

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in Figure 2 and Figures 6 and 8. Meunier and Hoppe are analogous art because both references are in the same field of endeavor, such as the coded sheet technology. It would have been obvious to one of ordinary skill in the art to include the ink, barcode, and the plurality of sheets of Meunier to the multilayer carrier of Hoppe because Meunier provides printed ink and a barcode on a sheet or a plurality of sheets for the purpose of identifying the sheet and for use in documents such as magazines or books for identifying the plurality of sheets when used in storage and retrieval (col. 7, lines 45-50 and col. 10, lines 50-51 of Meunier). With respect to the limitation "for configuring operations to form images..." (instant claims 1-2 and 31) is not given patentable weight because it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647.

Further to instant claim 3, to the fluid-based marking having bled onto the facial portions is inherent as the ink is printed onto the surface of the sheet(s).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking to carry the fluid-based marking onto the face portion from the edge portion, the Examiner interprets that the sheet of the prior art does not have such sufficient capillary action.

To claims 35-36, that the fluid-based marking was generated in part as a function and positioning of a mask, where the mask having been placed over the sheet and having been offset at an angle of skew are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

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Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same. Further, the mask is not part of the sheet media, the mask is not adding any positive recitation to the claims.

To claim 39, that each of the sheets are being skewed at an angle is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Response to Arguments

Applicant's arguments filed 07-30-04 have been fully considered but they are not persuasive.

Applicant argues the 112 claim rejection over claim 3, alleging ink markings can be on the face and still not imprinted on the face. The Applicant has not persuasively argued because the ink-bled marking 102 is from a printing system as the disclosure describes on page 6 (see line 15). Page 6 of Applicant's specification defines ink-bled markings as being imprinted, thus because claim 1 states the single fluid ink marking is on a portion, then it is imprinted, which is

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in direct opposition to claim 3 that states the single fluid ink marking is not imprinted. Further Applicant should note the confusion of Figure 3 as the specification describes on page 6 that references 302 to an ink nozzle and a stack of print media. A single reference number can't identify two different entities. Applicant argues Hoppe teaches printing over the edge, not on it. The Examiner does not agree because Figure 3 of Hoppe shows the print touching at least one point along the edge, including the corner. Meunier further shows printing ink on edges. Applicant has not claimed any distance or excluded any section of an edge from receiving indicia. Applicant argues identification data is not data for configuring imaging device. As previously set forth, Hoppe does not disclose the printed identification data, ~~but Meunier~~. ²⁰ _{1.2.0f} Meunier discloses marking an edge of the sheet or sheets of material with indicia arranged to form a unique code identifying the sheet of material such as a barcode, which is the same identification data for configuring an image as Applicant claims. Both Hoppe and Meunier are analogous art as they are in the same field of endeavor, namely coded technology on sheets.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamra L. Dicus
Examiner
Art Unit 1774

October 8, 2004


RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 10/13/04